

Application No.: 09/653,286  
Amendment

R E M A R K S

Reconsideration of the application in view of the above amendments and the following remarks is respectfully requested. Claims 1, 6, 7 and 12-16 have been amended, claim 19 has been canceled without prejudice, and new claims 20-27 have been added. Therefore, claims 1-18 and 20-27 are pending in the application.

Extension of Time

A petition and fee for a one-month extension of time is submitted herewith to extend the due date for response to the Final Office Action until January 24, 2004.

Written Statement regarding Substance of 12/11/03 Interview per 37 CFR 1.133(b)

Applicants appreciate very much the opportunity to discuss the rejections in this application with Examiner Good-Johnson in the telephone interview that occurred on December 11, 2003, at 1:00 p.m. EST. In accordance with the requirements of 37 CFR 1.133(b), and the Manual of Patent Examining Procedure (MPEP) §713.04, Applicants provide the following written statement of the reasons presented at the interview as warranting favorable action.

No exhibits were shown or discussed. The claim that was discussed was independent claim 1. The prior art that was discussed was U.S. Patent No. 6,296,570 to Miyamoto et al. ("Miyamoto et al.").

No specific proposed amendments were discussed. However, the Examiner indicated that she believed that the color of the word in Applicants' claims indicates some type of previous event or prior condition that has taken place. The Examiner indicated that she would possibly attempt to devise a proposed amendment

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and contact the undersigned. The undersigned did not hear back from her in this regard.

The general thrust of the Applicants' principal arguments that were discussed in the interview were as follows:

(i) Applicants argued that in the rejection of claim 1 a *prima facie* case of obviousness has not been established because there is a lack of supporting documentary evidence and references showing Applicants' claimed "words of a same type in meaning in said message are displayed in a same color", which Applicants submit is not common knowledge or well-known; and

(ii) Even if Miyamoto et al. were modified in the manner suggested by the Examiner it would still not disclose Applicants' claimed "words of a same type in meaning in said message are displayed in a same color" because such a modification to Miyamoto et al. would merely indicate how to use the controller in the action game and would not indicate the meaning of the word itself in the scenario of the game, such as whether a game character has already visited the place indicated by the word.

Regarding the first (i) argument, the Examiner indicated that she would consider the argument and call the undersigned back. She did call the undersigned on December 18, 2003, and left a voice mail message indicating that she disagreed with the argument and would maintain the final rejection. Regarding the second (ii) argument, the Examiner indicated that she disagreed and that in her opinion all words have meaning, including the words in Miyamoto et al.

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Written Statement regarding Substance of 1/13/04 Interview per  
37 CFR 1.133(b)

Applicants also appreciate very much Examiner Good-Johnson's willingness to grant the second telephone interview that occurred on January 13, 2004, at 2:00 p.m. EST. In accordance with the requirements of 37 CFR 1.133(b), and the Manual of Patent Examining Procedure (MPEP) §713.04, Applicants provide the following written statement of the reasons presented at the interview as warranting favorable action.

No exhibits were shown or discussed. The claim that was discussed was independent claim 1. The prior art that was discussed was U.S. Patent No. 6,296,570 to Miyamoto et al. ("Miyamoto et al.").

The principal proposed amendment that was discussed is the amendment to claim 1 set forth in the above amendment.

The general thrust of the Applicants' principal arguments that were discussed in the interview were that Miyamoto et al. does not disclose a color of words of a category changing after an event or a condition occurs.

The outcome of the interview was that the Examiner said that the proposed amendment to claim 1 would require further searching and consideration and that a Request for Continued Examination (RCE) must be filed for her to perform the searching and consideration.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,296,570 to Miyamoto et al. ("Miyamoto et al."). Applicants respectfully traverse these rejections.

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Applicants' amendment to claim 1 takes into account a comment made by the Examiner in the Interview conducted on December 11, 2003. Namely, the Examiner indicated that she believed that the color of the word in Applicants' claims indicates some type of previous event or prior condition that has taken place. For example, the color of the word may indicate whether the character has previously visited the place. Or, the color of the word may indicate whether the character has already met the person. The Examiner indicated in the Interview that she would consider an amendment along these lines.

Applicants' amendment to claim 1 captures this concept by reciting that the message is displayed such that "a color of words of a category changes after an event or a condition occurs". For example, if the character has already visited the place, the name of the place in the message may be displayed in yellow, and if the character has not previously visited the place, the name of the place may be displayed in brown. In this example, the event or condition is whether or not the character has already visited the place. Applicants have amended independent claims 6, 7 and 12 in a similar manner.

Applicants submit that the amendment is fully supported by Applicants' specification on page 26, line 26 through page 29, line 5, and throughout the specification. For example, see page 27, lines 23-25, which states: "[i]n this manner, the words in the message are categorized and distinguished by different colors." Furthermore, Applicants submit that the Examiner's indication during the Interview conducted on December 11, 2003, that she believed that the color of the word in Applicants' claims indicates some type of event or condition that has taken place is further evidence that the amendment is supported by the specification. Namely, Applicants believe that the Examiner

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would not have come to this conclusion unless Applicants' specification taught this concept.

Applicants submit that the amendment to claim 1 makes claim 1 patentable over U.S. Patent No. 6,296,570 to Miyamoto et al. ("Miyamoto et al."). Specifically, Miyamoto et al.'s FIG. 12 discloses a game system in which a message is displayed in a display area 31a of the screen for informing the player of the method of manipulating a player object (fighter airplane) 60. Images of buttons corresponding to four buttons 47C of a controller 40 manipulated by the player are also displayed near the message. One of the buttons 47C is displayed in a color different from the other buttons for prompting the player to press the button displayed in the different color.

Miyamoto et al.'s concept of displaying the button in a different color is quite different from the concept recited in Applicants' amended claim 1. Namely, Miyamoto et al. is directed to indicate which button is associated with the required action. Miyamoto et al. teaches how to use the controller of the game by displaying an image of a button in a certain color. But Miyamoto et al. in no way teaches or discloses the concept recited in Applicants' amended claim 1 that "a color of words of a category changes after an event or a condition occurs". This is because, as admitted by the Examiner, Miyamoto et al. fails to disclose words of a same type in meaning in a same color on the displayed message. (see Final Office Action mailed 9/24/03, page 3, second paragraph). As such, Miyamoto et al. certainly does not disclose a color of words of a category changing after an event or a condition occurs. Furthermore, Miyamoto et al.'s colored button is not a word and does not indicate an event or condition that has taken place, such as a place having been previously visited or a person having been previously met. Instead, Miyamoto et al.'s

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colored button merely indicates which button is associated with the required action.

Moreover, Applicants submit that their amended claim 1 would not be obvious in view of Miyamoto et al. Namely, in the Final Office Action the Examiner proposed that Miyamoto et al.'s colored button could be coordinated with a word for the operation being performed (see Final Office Action mailed 9/24/03, page 3, second paragraph). Applicants submit, however, that this proposed modification simply does not establish a *prima facie* case of obviousness because the Examiner has not shown the proper motivation to make the modification. This is because, as Applicants argued in the Interview conducted on December 11, 2003, the Examiner has not cited an additional reference or supporting documentary evidence that shows the subject matter of the proposed modification and the motivation to make the proposed modification. That is, the Examiner has not shown a colored button coordinated with a word for the operation being performed in a reference that is properly combinable with Miyamoto et al.

Applicants also respectfully disagree that it would be inherent in Miyamoto et al. to coordinate a colored button with a word for the operation being performed. This is because the Examiner has simply not identified a specific teaching in Miyamoto et al. that would suggest such inherency. Furthermore, if the Examiner is attempting to base this conclusion of obviousness on Official Notice or upon Common Knowledge, then pursuant to MPEP § 2144.03(C) Applicants hereby traverse and challenges such factual assertions as not properly officially noticed or not properly based upon common knowledge. Specifically, the error in the Examiner's action is that she has not provided any supporting documentary evidence that teaches or suggests the extra features and limitations in the proposed

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modification of Miyamoto et al. Furthermore, Applicants submit that those limitations are simply not common knowledge or well-known in the art.

Furthermore, even if Miyamoto et al. were somehow modified such that its colored button were coordinated with a word for the operation being performed as proposed by the Examiner, there would still be no disclosure of a color of words of a category that changes after an event or a condition occurs as recited in Applicants' amended claim 1. In other words, the Examiner's proposed modification of Miyamoto et al.'s system to have the color of a certain action word indicate which button is associated with the action still does not disclose that the color of the word indicates some type of event or condition that has taken place.

In summary, Miyamoto et al.'s disclosure of one of the buttons 47C being displayed in a color different from the other buttons is very far from the concept recited in Applicants' amended independent claims 1, 6, 7 and 12 that "a color of words of a category changes after an event or a condition occurs". As such, the rejections of amended independent claims 1, 6, 7 and 12 must be withdrawn. Furthermore, the rejections of claims 2-5, 8-11 and 13-18 must also be withdrawn for at least these same reasons due to their dependency on their respective independent claims.

Applicants have also amended dependent claims 13, 14, 15 and 16 to make them consistent with independent claims 1 and 6. Applicants submit that dependent claims 13-18 are certainly patentable over Miyamoto et al. because they add further limitations along the lines of the features discussed above.

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New Claims 20-27

Applicants have added new dependent claims 20, 22, 24 and 26, which recite "wherein the category comprises a place category and the color of a word of the place category indicates whether a character has previously visited the place", as well as new dependent claims 21, 23, 25 and 27, which recite "wherein the category comprises a person category and the color of a word of the person category indicates whether a character has previously met the person". Applicants submit that these amendments are clearly supported by the portions of the specification cited above for the amendment to claim 1.

Applicants submit that these new dependent claims are clearly patentable over Miyamoto et al. because the limitations of these claims are simply not disclosed or suggested by Miyamoto et al. Additionally, the claims are patentable over Miyamoto et al. for at least the same reasons provided above due to their dependency on their respective independent claims.

Fees Believed to be Due

Fees were previously paid in this application for a total of 20 claims with 4 claims being independent claims. The above amendment has resulted in there now being a total of 26 claims with 4 claims being independent claims. As such, a fee is due for 6 extra total claims.



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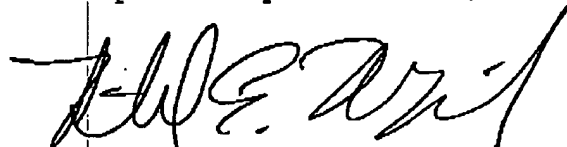
C O N C L U S I O N

In view of the above, Applicants submits that the pending claims are in condition for allowance. Should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone Richard E. Wawrzyniak at (858) 552-1311 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

Dated

1/21/04



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